

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

TAKATORI *et al.*

Appl. No.: 10/089,122

Filed: March 22, 2002

For: **Authentication Managing Apparatus,
and Shop Communication Terminal**

Confirmation No.: 9087

Art Unit: 3691

Examiner: TINKLER, MURIEL S.

Atty. Docket: 2222.6100001

Arguments to Accompany the Pre-Appeal Brief Request for Review

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Commissioner for Patents
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Sir:

Applicants hereby submit the following Arguments, in five (5) or less total pages, as attachment to the Pre-Appeal Brief Request for Review Form (PTO/SB/33). A Notice of Appeal is concurrently filed.

Arguments

Applicants' arguments in the Reply under 37 C.F.R. § 1.111 filed April 24, 2008 and the Reply under 37 C.F.R. § 1.116 filed December 2, 2008 (collectively the "Replies"), filed in response, respectively, to the Office Action mailed March 12, 2007 and the withdrawn Final Office Action mailed October 3, 2008 (collectively the "Prior Office Actions"), were not properly considered by the Examiner in the new Final Office Action issued December 24, 2008 ("Final Office Action"). In particular, the response in the Final Office Action failed to adequately convey where the applied references teach or suggest the distinguishing features of "a transfer device configured to transfer money indicated by the monetary amount information," as recited in claim 1, "a transmitter configured to transmit the store ID information, the customer ID information and the monetary amount information," as recited in claim 4, "transferring money indicated by the monetary amount information," as recited in claim 24, "transmitting store ID information, the customer ID information, and the monetary amount information," as recited in claim 25, "transfer money indicated by the monetary

amount information,” as recited in claim 26, and “transmit store ID information, the customer ID information, and the monetary amount,” as recited in claim 27.

1. The Examiner Has Not Provided Applicants a Full and Fair Hearing

The Final Office Action rejected claims 1-6, 11, and 24-29 as allegedly being obvious under 35 U.S.C. § 103(a) over U.S. Patent No. 6,738,749 to Chasko (“Chasko”) in view of U.S. Patent No. 6,047,270 to Joao et al. (“Joao”). Applicants respectfully traverse.

A significant portion of Applicants’ Replies discussed at least the above-noted distinguishing features of claims 1, 4, and 24-27 such as, e.g., pages 11-13 of the Reply under 37 C.F.R. § 1.116 filed December 2, 2008. The Examiner does not address the Applicants’ arguments in either (a) the Response to Arguments section (*see* Final Office Action, pp. 2-3) or (b) the rejection with respect to the Applicants’ arguments (*see* Final Office Action, pp. 3-4; *compare with* withdrawn Office Action mailed October 3, 2008, pp. 3-4 and Office Action mailed March 12, 2007, pp. 3-5). The Examiner’s failure to properly response to Applicants’ arguments was improper in view of M.P.E.P. § 706.07, which states, “[t]he examiner should never lose sight of the fact that in every case the applicant is entitled to a ***full and fair hearing***, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.” As a consequence of the Examiner’s failure to fully address Applicants’ arguments, Applicants find it necessary to submit the arguments for consideration before an Appeal.

2. Claims 1, 4, and 24-27 Are Not Rendered Obvious by the Combination of Chasko in View of Joao

In the Prior Office Actions, the Examiner relied solely on Chasko as allegedly anticipating independent claims 1, 4, and 24-27, relying upon Field of the Invention, Background of the Invention, FIG. 1 (element 113), FIG. 7a (element 706), FIG. 8 (element 806), FIG. 8a (element 858), FIG. 9 (element 906), FIG. 10 (element 1008), FIG. 11 (element 1104), column 7 (lines 49-67), and column 8 (line 1) through column 11 (line 50) of Chasko to allegedly show at least the above-mentioned distinguishing features. Although the present rejection in the Final Office Action is over the combination of Chasko and Joao under 35 U.S.C. § 103(a), the Examiner continues to rely solely on Chasko as allegedly showing at least the above-mentioned distinguishing features. The Examiner does not rely on Joao to

teach or suggest, nor does Joao teach or suggest, at least the above-mentioned distinguishing features.

The system of Chasko is directed to creating, storing, and retrieving secure *transaction receipts*. These *transaction receipts* may be stored on portable electronic media that can be carried by a customer. Each transaction receipt contains information detailing the product or service purchased, as well as a merchant ID and a customer ID and an encrypted signature created from the data (Chasko, Abstract), which does not render obvious at least the above-mentioned distinguishing features.

Element 113 of FIG. 1 in Chasko is a *communications adaptor* used in computers to communicate with each other (Chasko, col. 3, ll. 61-64), which does not render obvious at least the above-mentioned distinguishing features.

Also, FIG. 7a of Chasko illustrates a process for interchange of data between a merchant secure medium, a customer secure medium, and a Point-of-Sale (POS) terminal. At step 706 of FIG. 7a, the customer secure medium sends data to the POS terminal consisting of a command status indicator, the customer ID, the block of customer random data, and the encrypted block of customer random data (Chasko, col. 7, line 49 - col. 8, line 7), which does not render obvious at least the above-mentioned distinguishing features.

Further, FIG. 8 of Chasko illustrates a process for *generating a merchant signature* and writing it to the customer secure medium. At step 806, the merchant secure medium sends the merchant signature to the POS terminal (Chasko, col. 9, ll. 25-27 and 41-43), which does not render obvious at least the above-mentioned distinguishing features.

Furthermore, FIG. 8a of Chasko illustrates an alternate process for *generating a merchant signature* and writing it to the customer secure medium. At step 858, the merchant secure medium sends the merchant signature to the POS terminal (Chasko, col. 9, ll. 64-66; col. 10, ll. 14-16), which does not render obvious at least the above-mentioned distinguishing features.

Also, FIG. 9a of Chasko is a process for *generating an optional customer signature*, and writing it to the customer medium. At step 906, the customer secure medium sends the customer signature to the POS terminal (Chasko, col. 10, ll. 37-39 and 53-55), which does not render obvious at least the above-mentioned distinguishing features.

FIG. 10 of Chasko illustrates a process for *verifying a merchant signature* stored on a customer secure medium. At step 1008, the POS terminal sends a 'Verify Detailed Receipt'

command to the merchant secure medium. This command instructs the merchant secure medium to verify the detailed transaction data from the secure customer medium (Chasko, col. 10, ll. 61-63; col. 11, ll. 7-11), which does not render obvious at least the above-mentioned distinguishing features.

Finally, FIG. 11 of Chasko is a process for *verifying a customer signature* stored by a merchant on a POS database. At step 1104, the merchant secure medium sends the merchant ID to the POS terminal (Chasko, col. 11, ll. 24-26 and 34-35), which does not render obvious at least the above-mentioned distinguishing features.

Therefore, the applied references cannot be used to form a prima facie case of obviousness for the claims.

Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 1, 4, and 24-27 under 35 U.S.C. § 103(a).

3. *Claims 2, 3, 5-23, 28, and 29 Are Also Not Rendered Obvious by the Combination of Chasko in View of Joao, and Further in View of Various Combinations with Benton, Woolston, Gustin, and Fernandez*

Claims 2, 3, 5-23, 28, and 29¹ depend from independent claims 1 and 4, and are not rendered obvious by the combination of Chasko and Joao for at least the same reasons discussed above with regard to claims 1 and 4, and further in view of their own respective features. The additional applied references, Benton, Woolston, Gustin, and Fernandez, are not stated by the Examiner in the Office Action as disclosing at least the above-mentioned distinguishing features, nor do they disclose at least the above-mentioned distinguishing features. Thus, because the additional applied references cannot be used to cure the deficiencies of Chasko and Joao, the applied references cannot be used to form a prima facie case of obviousness for the claims. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the various rejections of claims 2, 3, 5-23, 28, and 29 under 35 U.S.C. § 103(a).

¹ Claims 3, 7, 12, 16 and 20 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chasko in view of U.S. Patent No. 4,625,276 to Benton *et al.* ("Benton"). Claims 8, 13, 17 and 21 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chasko in view of U.S. Patent No. 6,085,176 to Woolston ("Woolston"). Claims 9, 14, 18 and 22 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chasko in view of U.S. Patent No. 6,012,048 to Gustin *et al.* ("Gustin"). Claims 10, 15, 19 and 23 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chasko in view of U.S. Patent No. 6,266,647 to Fernandez ("Fernandez"). Claims 28 and 29 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Chasko in view of U.S. Patent No. 6,999,943 to Johnson *et al.* ("Johnson").

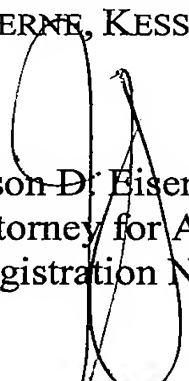
4. Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) of claims 1-6, 11, and 24-29 over Chasko and Joao; claims 7, 12, 16, and 20 over Chasko, Joao, and Benton; 8, 13, 17, and 21 over Chasko, Joao, and Woolston; claims 9, 14, 18, and 22 over Chasko, Joao, and Gustin; and claims 10, 15, 19, and 23 over Chasko, Joao, and Fernandez.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

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